

GOLD SPONSORS

Knobbe Martens



SILVER SPONSORS

Akin Gump
STRAUSS HAUER & FELD LLP

BRONZE SPONSORS



Interested in becoming a sponsor? Click [HERE](#) to email the OCIPLA Board of Directors.

FEDERAL CIRCUIT SUMMARIES

Contributors: Knobbe Martens

Federal Circuit Affirms Exceptionality Based On Inadequate Pre-Suit Investigation of Infringement

In [Thermolife International LLC v. GNC Corporation](#), Appeal Nos. 2018-1657, 2018-1666, the Federal Circuit determined that a case may be exceptional if the plaintiff failed to conduct an adequate pre-suit investigation into infringement, even if the issue of infringement was not adjudicated.

ThermoLife International and Stanford University filed infringement suits against numerous nutritional supplement companies, including Hi-Tech Pharmaceuticals, Vital Pharmaceuticals and GNC Corporation, asserting selected claims from four patents. The district court held all asserted claims invalid and did not adjudicate the issue of infringement. The district court also granted Hi-Tech's and Vital's motion for attorney's fees, holding the cases to be exceptional on the basis that ThermoLife and Stanford failed to conduct an adequate pre-suit investigation regarding infringement. The district court found that an adequate investigation, including examining product labels or conducting simple testing on the publicly-available accused products, would have revealed that the accused products did not infringe.

The Federal Circuit reviewed the exceptional-case determination for abuse of discretion. The Federal Circuit held that the district court acted within its discretion in determining that ThermoLife and Stanford did not conduct an adequate pre-suit investigation into infringement and that such a determination was sufficient to support the exceptional case determination. Resting the exceptional case determination on an examination of the infringement issue, which had not been adjudicated, was not found to be an abuse of discretion. The Federal Circuit noted that where the issue presented as a basis for fees has not previously been litigated, the rationale for deference to the district court is weaker and a fuller explanation of the district court's assessment of a litigant's position may be needed. Additionally, the Federal Circuit explained that more process may be needed when the issue presented as the basis for fees was not previously litigated to ensure that procedural rights are respected. However, there was no persuasive reason for holding that the non-adjudicated issue of infringement as a basis for fees was a legally impermissible one in this case.

MORE INSIDE:

Internet Sightings — p. 8

OCIPLA Committees—p. 9

FEDERAL CIRCUIT CASE SUMMARIES

Regulatory Guidelines That Recite a Goal Without A Means to Achieve It Are of Limited Value As Prior Art

In *Endo Pharm, Inc., v. Actavis LLC*, Appeal No. 2018-1054, the Federal Circuit held that regulatory guidelines addressing drug product impurities may serve as a market force in motivating a PHOSITA to modify prior art references. However, if the guidelines lack a solution overcoming the impurity issues, they cannot provide a PHOSITA with a reasonable expectation of success in achieving the claimed purity levels.

Endo asserted patent claims against Actavis covering a purified form of oxymorphone, a compound used for pain relief. Actavis argued that the claims were invalid as obvious in view of several prior art references, including FDA guidelines requiring that oxymorphone compounds contain less than 0.001% of a particular impurity, a limitation that Endo incorporated into its claims and relied on for patentability. The district court rejected Actavis' obviousness arguments, reasoning that there was insufficient evidence to show that a PHOSITA would have had a reasonable expectation of success in combining the cited prior art to achieve the claimed invention.

The Federal Circuit affirmed, agreeing that the FDA guidelines provided an economic incentive to achieve the patented invention, but also that they did not provide any instruction on *how* to achieve that result. Thus, the FDA guidelines failed to adequately motivate a PHOSITA to combine the other cited prior art references with a reasonable expectation of success. Judge Stoll dissented, emphasizing that the FDA guidelines comprised every limitation in the claims, and criticizing the majority for conflating the enablement and "reasonable expectation of success" inquiries.

Trademark decisions rendered by the International Trade Commission do not have preclusive effect

In *Swagway, LLC v. ITC*, Appeal No. 2018-1672, the Federal Circuit held that trademark decisions of the International Trade Commission, like the Commission's patent decisions, do not have preclusive effect.

Segway filed a complaint with the International Trade Commission ("ITC") alleging that Swagway's products marketed under the names SWAGWAY X1 and X2, as well as SWAGTRON T1 and T3, infringed

Segway's SEGWAY marks. The ITC instituted an investigation. Swagway moved for partial termination of the investigation on the basis of a consent order stipulation, which Swagway amended on two separate occasions. Segway opposed the stipulation and proposed consent order. The ALJ scheduled a hearing on the investigation. During a prehearing conference, counsel for Swagway inquired about the pending motion for consent order. The ALJ indicated that because of the number of versions and the amount of briefing the motion for consent order would not be ruled on before the hearing. After the hearing, the ALJ issued an Initial Determination ("ID"), finding that Swagway's use of the SWAGWAY designation—but not its use of the SWAGTRON designation—infringed Segway's marks. THE ALJ's ID did not mention Swagway's motion for termination based on its consent order stipulation. Swagway filed a petition for review of the ALJ's finding of trademark infringement, as well as the denial of its consent order motion.

The Commission determined not to review the ALJ's denial of Swagway's consent order motion. As for the finding on trademark infringement, the Commission issued an opinion reversing the ALJ's determination on the existence of actual confusion because the incidents of confusion were small compared to the volume of sales of Swagway's products. However, the Commission affirmed the ALJ's ultimate finding of trademark infringement because evidence supporting the other likelihood of confusion factors strongly supported the finding of infringement. Swagway appealed the Commission's finding of trademark infringement and its failure to enter the proposed consent order.

The Federal Circuit affirmed the Commission on both issues. As for the trademark infringement finding, the Court considered the factors set forth in *In re E.I. DuPont DeNemours*. The Court noted that although the *DuPont* factors are the framework for assessing likelihood of confusion for purposes of registration, the Supreme Court recently ruled that likelihood of confusion for purposes of registration is the same standard as likelihood of confusion for purposes of infringement in the *B&B Hardware* case. The Court also explained that the Commission need only "consider those factors which are supported by evidence in the record." The Court then turned to Swagway's argument that the Commission should have found the lack of actual confusion dispositive in this case. The court rejected this argument. Swagway also argued that the Commission failed to "properly re-weigh the likelihood-of-confusion factors" after it reversed the ALJ's determination regarding actual confusion. The Court rejected this argument as a

FEDERAL CIRCUIT CASE SUMMARIES

mischaracterization of the Commission's decision which, the court found, *did* reweigh the factors. Finally, Swagway argued that Segway's failure to conduct a survey should create an adverse inference. The Federal Circuit, however, observed that consumer survey evidence "is not required to show a likelihood of confusion," and, thus, found that the Commission did not err by failing to draw such an inference.

As for the consent order, the Court did not believe there was any difference between Swagway's proposed consent order and the Commission's orders. Under either, the SWAGWAY-branded products at issue could not be imported into or sold within the United States. Swagway argued that preclusive effect would be given to the Commission's orders and sought entry of its proposed consent order to avoid issue preclusion in a co-pending stayed district court case. The Federal Circuit held that the Commission's trademark decisions, like its patent decisions, do not have preclusive effect.

The Plain and Ordinary Meaning of a Claim Term Applies Absent a Clear Redefinition

In [*Bradium Technologies LLC v. Andrei Iancu*](#), Appeal Nos. 2017-2579, 2017-2580, the Federal Circuit held that a clear and unambiguous definition of a claim term is required to redefine the term to convey something other than its plain and ordinary meaning.

Microsoft requested inter partes review of two patents owned by Bradium. The patents at issue were directed to retrieving large-scale images over network communication channels in low bandwidth conditions to display such images on client devices with limited processing powers. Bradium argued that the claims should be construed to narrowly define "limited bandwidth communication channel" to mean "a wireless or narrowband communications channel," such that the claimed channel is "substantially permanently limited in bandwidth due to technical constructs on the channel itself." Bradium asserted that this construction was supported by a statement in the shared written description of both patents that "limited bandwidth conditions may exist due to either the direct technological constraints dictated by the use of a low bandwidth data channel or indirect constraints imposed on relatively high-bandwidth channels by high concurrent user loads." The Board rejected Bradium's construction and, instead, construed the claim term to have its plain and ordinary meaning of "a communications channel whose bandwidth is limited." The Board noted that the patents' specifica-

tions did not define the term and that the plain and ordinary meaning was consistent with the inventor's testimony. Based on this construction, the Board invalidated the claims over the cited prior art.

The Federal Circuit affirmed the Board's decision. The Federal Circuit acknowledged that the cited statement in the shared written description does distinguish between low-bandwidth and high-bandwidth channels, but the statement does not provide that a *limited* bandwidth communications channel cannot be a high-bandwidth channel. The Federal Circuit reasoned that the statement actually supports the Board's construction because it makes it clear that limited bandwidth can result from either "direct technological constraints" or "indirect constraints" such as "high concurrent user loads." Furthermore, the Federal Circuit explained that a single statement describing two causes for limited bandwidth is not a clear and unambiguous definition limiting the term to only one cause and derogating from the term's plain and ordinary meaning. Accordingly, the Federal Circuit affirmed the Board's decision finding that all challenged claims were invalid as obvious.

Lead Compound Analysis Improper When Evaluating a Method of Using a Compound

In [*Novartis Pharmaceuticals Corp v. West-Ward Pharmaceuticals*](#), Appeal No. 2018-1434, the Federal Circuit found that when a method of using a prior art compound is claimed rather than the compound itself, the standard for motivation to combine is whether a person of skill in the art would have been motivated to modify the prior art disclosing the compound. A limited pharmaceutical study may not be enough to show that a person of ordinary skill in the art would have had a reasonable expectation of success.

Novartis sued West-Ward to assert its patent on a method of using the drug Everolimus to treat advanced renal cell carcinoma ("RCC"). The district court found that West-Ward failed to prove by clear and convincing evidence that the patent was invalid as obvious. The Federal Circuit affirmed the district court's decision, finding that while the district court erred in its motivation-to-combine analysis, the error was harmless because the district court did not clearly err in finding a lack of a reasonable expectation of success.

With regard to the motivation-to-combine analysis, the Federal Circuit determined that the district court erred in applying a lead compound analysis to the claims at issue. In particular, since the claims at issue were directed to a method of using a compound rather than the compound itself, the proper standard was not whether a per-

FEDERAL CIRCUIT CASE SUMMARIES

son of ordinary skill in the art would have *selected* the compound, but rather whether the person of ordinary skill in the art would have been *motivated to modify* the prior art disclosing the compound. Since the district court found that a person of ordinary skill would have been motivated to pursue the drug as one of several options, the Federal Circuit found that the standard was met and there would have been a motivation to combine.

With regard to the reasonable-expectation-of-success analysis, the Federal Circuit determined that the district court did not clearly err in its finding that a person of ordinary skill in the art would not have had a reasonable expectation of success because the molecular biology of the prior art compound was not fully understood and there were limitations in the available phase I data regarding the compound. Thus, the Federal Circuit affirmed the district court's conclusion that the patent at issue would not have been obvious in view of the asserted prior art.

Federal Circuit Appeal Dismissed Where Party Appealing PTAB Decision Lacked Article III Standing

In [*AVX Corporation v. Presidio Components, Inc.*](#), Appeal No. 2018-1106, the Federal Circuit held that an appellant from an IPR decision must have a concrete claim of a current or non-speculative interest in practicing a claimed invention of the patent at issue in order to have standing to appeal.

AVX requested inter partes review of a patent owned by Presidio. The patent at issue described and claimed single-layer ceramic capacitors with certain features. AVX manufactures and sells a variety of electronic components, including capacitors. AVX argued that all 21 of the claims under Presidio's patent were unpatentable based on obviousness. The PTAB held that five of the claims were unpatentable but the remaining 16 claims were upheld. AVX appealed the PTAB's decision as to the upheld claims and Presidio responded by arguing that AVX lacked the standing required to appeal the Board's decision in an Article III court.

The Federal Circuit concluded that AVX lacked standing and dismissed the case without evaluating the merits of the Board's ruling. For a party to have standing in an Article III court, it must show 1) injury in fact, 2) a causal connection between the injury and the conduct complained of, and 3) a likelihood that the injury will be redressed by a finding in their favor. The Federal Circuit rejected AVX's assertion that it was injured because the statutory estoppel provision, 35

U.S.C. § 315(e), would prevent it from asserting the same challenge if Presidio asserts the patent claims against AVX in the future. The Federal Circuit also rejected AVX's argument that AVX was injured because the Board's decision reduces AVX's ability to compete with Presidio. The Federal Circuit found that AVX lacked any current or non-speculative interest in practicing the upheld claims as they had not established any concrete plans to develop a capacitor that might implicate those claims. Thus, the Federal Circuit found that AVX failed to establish an injury in fact and dismissed AVX's appeal.

Broad Description in Specification Defeats Patent Owner's Bid for Narrow Construction

In [*BTG International Limited v. Amneal Pharmaceuticals LLC*](#), Appeal No. 2019-1147, the Federal Circuit determined that the PTAB correctly construed the term "treatment" in light of the challenged patent's specification to include treatments seeking anti-cancer effects as well as treatments that reduce side effects.

BTG International and other plaintiffs (collectively, "BTG") sued Amneal Pharmaceuticals and other defendants in the District of New Jersey, asserting that the defendants' Abbreviated New Drug Applications infringed all claims of U.S. Patent No. 8,822,438. Subsequently, three groups of defendants filed separate inter partes review petitions. In all three IPRs, the PTAB issued claim constructions adverse to BTG and found all claims of the patent obvious over the asserted prior art. The district court found the claims obvious over the same prior art. BTG appealed from both the district court and the PTAB.

The claims at issue were directed to a method for the "treatment of a prostate cancer in a human comprising administering" abiraterone, a well-known anti-cancer agent, and prednisone. BTG argued that the term "treatment" required abiraterone and prednisone to each have an anti-cancer effect. The Federal Circuit disagreed with BTG and affirmed the PTAB's holding that "treatment" allowed for uses in which abiraterone has an anti-cancer effect and prednisone has some other benefit, such as reducing side effects. The Federal Circuit explained that the specification described prednisone as an anti-cancer agent *and* a steroid, thus suggesting that "treatment" includes effects of steroids other than anti-cancer effects.

Applying the PTAB's construction, the Federal Circuit held that substantial evidence supported the obviousness determination in one of the IPRs. Further, the Federal Circuit held that substantial evidence would

FEDERAL CIRCUIT CASE SUMMARIES

support that determination even under BTG's proposed construction. Based on this affirmation of the obviousness determination in one IPR, the Federal Circuit dismissed the remaining appeals as moot.

Lack of Evidence on Efficacy Invalidates Patent on Combination Drug

In [*Nuvo Pharmaceuticals v. Dr. Reddy's Laboratories, Inc.*](#), Appeal Nos. 2017-2473, -2481, -2484, -2486, 2489, -2491, 2492, -2493, the Federal Circuit held that a written description is not satisfied when the claimed drug is understood to be ineffective by a person skilled in the art and the description includes only making and using the drug.

Dr. Reddy's Laboratories, Mylan, and Lupin (collectively, "the Generics") filed two ANDAs with the FDA seeking to market generic variants of Vimovo[®], a combination tablet including a non-steroidal anti-inflammatory (NSAID) and a proton pump inhibitor (PPI). Nuvo and Horizon (collectively, "Nuvo") filed a patent infringement suit against the Generics in the U.S. District Court for the District of New Jersey. NSAIDs, used to treat pain, have the undesirable side effect of causing gastrointestinal problems. PPIs can be used in combination with NSAIDs to address this side effect by raising pH levels in the intestines. However, stomach acid may degrade the PPIs before they reach the intestines. To address this, PPIs are coated to time their release. Nuvo's patents claim formulations for a combination of NSAID and uncoated PPI. Among other defenses, defendants asserted the patents lacked written description for failing to describe the efficacy of uncoated PPI. Following a bench trial, the district court upheld the validity of the asserted claims.

The Federal Circuit reversed the district court's decision, finding the patent invalid for lack of written description on the efficacy of uncoated PPI. The Federal Circuit held that there was no evidence that the inventor possessed the claimed efficacy of uncoated PPI beyond a mere wish or hope. Merely describing the formulation of the drug is insufficient to demonstrate to a person of skill in the art that the uncoated PPI was effective because he or she would not have expected it to raise the intestinal pH levels. The Federal Circuit also rejected Nuvo's arguments that the efficacy was inherent in the drug formulation because the specification lacked any disclosure on the efficacy of uncoated PPI to raise intestinal pH levels.

Federal Circuit Explores the Sham Affidavit Doctrine

In [*Quest Integrity USA, LLC v. Cokebusters USA Inc.*](#), Appeal No. 2017-2423, the Federal Circuit held that an affidavit should not be dismissed as a sham where (1) the affidavit contradicts another witness's prior deposition testimony or (2) where the affidavit does not simply contradict the witness's own prior deposition testimony but instead provides a detailed explanation why the prior testimony was incorrect.

Quest Integrity sued Cokebusters for infringing the '874 patent, which related to the display of furnace inspection data. The district court granted summary judgment of invalidity on claims 12, 24, 30, 33, and 40, finding that the patented invention was offered for sale more than one year prior to the filing date (the "Norco sale"). Claims 33 and 40 required additional limitations not present in the other invalidated claims. On summary judgment, the district court interpreted Quest's corporate witness's deposition testimony to confirm that the Norco sale included the additional limitations in Claims 33 and 40. Quest's corporate witness and a co-inventor each submitted affidavits explaining why the corporate deposition testimony was inaccurate and incomplete. In granting summary judgment of invalidity, the district court rejected and disregarded the affidavits as shams.

The Federal Circuit affirmed the invalidity of claims 12, 24, and 33. For claims 30 and 40, the Federal Circuit examined the sham affidavit doctrine, which prevents a party from creating a material issue of fact by filing an affidavit that disputes prior sworn testimony without demonstrating a plausible explanation for the conflict. The Federal Circuit found that rather than merely contradicting his prior testimony, Quest's corporate witness submitted a detailed declaration supported by record evidence explaining his misstatements. The court held that Quest's corporate witness's affidavit was not a sham and raised an issue of material fact sufficient to defeat summary judgment. The court further held that the co-inventor's affidavit was similarly not a sham, because it also provided a detailed explanation why prior deposition testimony was incorrect. In addition, the co-inventor's affidavit was not a sham because it did not relate to the affiant's own prior deposition testimony, but instead clarified another witness's prior deposition testimony.

FEDERAL CIRCUIT CASE SUMMARIES

Means-Plus-Function Claiming in Computer-Implemented Inventions: Identifying the Corresponding Structure

In [Sony Corp. v. Iancu](#), Appeal No. 2018-1172, the Federal Circuit determined that: (1) Article III standing may exist over a patentee's appeal from the PTAB even when the patent is expired, underlying litigation has been resolved, and the petitioner has elected not to participate in the appeal; and (2) when a means limitation is computer-implemented, the corresponding structure must include an algorithm.

The PTAB instituted IPR as to two claims of a patent, which recite, in pertinent part, the means-plus-function limitation "reproducing means for reproducing the audio data of the channel designated by the default value stored in the storing means." The Board focused its inquiry into whether this means-plus-function limitation was computer-implemented, thus requiring an algorithm. The Board concluded that it was not computer-implemented and found the claims obvious over the prior art. The patentee appealed to the Federal Circuit. Because the related district court litigation had settled and the patent had expired prior to the appeal, the petitioner did not defend the Board's decision. Director Iancu intervened to defend the Board's decision.

The Federal Circuit first addressed the dissent's argument that there was no live case or controversy sufficient to satisfy Article III. Although the petitioners did not participate in the appeal, the parties to the appeal were adverse and no party suggested that there was a lack of an Article III case or controversy. Moreover, the expiration of the patent was relevant because the Court's decision would have had consequences on infringement that had occurred during the life of the patent. Therefore, the Federal Circuit found there was a case or controversy sufficient to satisfy Article III.

The Federal Circuit, reviewing the Board's construction de novo, went on to state that the patent "on its face" referred to a computer implementation of the reproducing means; the court thus determined the corresponding structure must include an algorithm. Figure 16 of the patent disclosed such an algorithm in the form of a flowchart. Because the Board made no determination as to whether the prior art disclosed the algorithm disclosed in the patent (or an equivalent thereof), the Federal Circuit vacated the Board's decision and remanded for further consideration of whether the prior art disclosed the algorithm.

Judge Newman's dissent argued that there was no Article III basis for the Federal Circuit to hear the ap-

peal. The parties had settled the infringement suit in district court, the patent had expired, and the prevailing party at the PTAB had declined to defend its victory. Thus, Judge Newman argued there was no interest, public or private, in the fate of the patent. Judge Newman noted that the Director did not explain the agency's interest in further judicial and administrative proceedings regarding an expired patent devoid of other controversy. Judge Newman concluded that the appeal, and the remand for further proceedings, were devoid of substance and consequence, and thus appeared to be advisory.

Applying Issue Preclusion on Appeal

In [Papst Licensing GmbH & Co. KG v. Samsung Electronics America, Inc. et al.](#), Appeal No. 2018-1777, the Federal Circuit found that issue preclusion can be applied for the first time at the Federal Circuit if the patentee voluntarily dismisses appeals for related patents prior to the Federal Circuit's decision.

Samsung requested inter partes review (IPR) of Papst's '437 patent. Before the PTAB issued a decision as to the '437 patent, it issued final written decisions in IPRs involving two related patents with the same specification. In all three decisions, the PTAB invalidated the claims as obvious over the prior art. Papst appealed all three decisions. Shortly before oral argument, however, Papst voluntarily dismissed its appeal as to the two related patents.

The Federal Circuit affirmed the PTAB's decision on the merits and also on the basis of issue preclusion. The Federal Circuit held that Papst's voluntary dismissal of appeals as to the two related patents rendered those IPR decisions final. Further, the PTAB's prior construction of materially identical claim terms, and findings regarding the prior art, in the other two IPRs raised the same "issues" as the appeal of the IPR concerning the '437 patent. Finally, those issues were essential to the PTAB's decision and Papst had a full and fair opportunity to litigate. Thus, the Federal Circuit applied issue preclusion and affirmed.

Rule 19 Joinder Provisions Are Not Optional

In [Lone Star Silicon Innovations v. Nanya Technology Corporation](#), Appeal No. 2018-1581, the Federal Circuit held that when a patent assignee does not acquire all substantial rights in a patent, Rule 19 compels courts to join a patentee as a necessary party, when feasible. Additionally, whether a party possesses all substantial rights in a patent does not implicate standing or subject matter jurisdiction.

FEDERAL CIRCUIT CASE SUMMARIES

Lone Star sued Appellees for infringement of several patents. A transfer agreement between Lone Star and AMD purported to transfer “all right, title, and interest” in the asserted patents to Lone Star. However, the transfer agreement permitted Lone Star to assert the patents against only unlicensed third parties specifically listed in the agreement. The transfer agreement also limited Lone Star’s right to abandon and transfer the patents. In view of these limitations, the district court found that Lone Star lacked all substantial rights in the patents and concluded that Lone Star could not sue in its own name. The district court refused to allow Lone Star to join AMD as a plaintiff and dismissed the suit against Appellees.

On appeal to the Federal Circuit, Lone Star argued that it possessed all substantial rights in the asserted patents because the transfer agreement purported to transfer “all right, title, and interest,” and in the alternative that it should have been permitted to join AMD as a necessary party. The Federal Circuit agreed with the district court that Lone Star did not possess all substantial rights in the asserted patents, rendering AMD a necessary party to the infringement lawsuit. The Federal Circuit then considered Lone Star’s argument that it should have been given an opportunity to join AMD as a necessary party before the case was dismissed. The Federal Circuit explained that under Fed. R. Civ. P. 19, courts must join a patentee, if feasible, when it is a necessary party. The Federal Circuit further explained that if it is not feasible to join a necessary party, the court must consider whether the case should proceed anyway or be dismissed because the party is indispensable. Because the district court failed to engage in this necessary analysis, the Federal Circuit remanded the case to the district court to consider the mandatory joinder provisions of Rule 19.

The Federal Circuit also considered Appellees’ argument that Lone Star lacked standing to bring suit because it had failed to allege that it was an exclusive licensee. The Federal Circuit rejected Appellees’ argument in view of *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014), explaining that whether a party possesses all substantial rights in a patent does not implicate standing or subject matter jurisdiction.



INTERNET SIGHTINGS

Internet Sightings

by Frederic M. Douglas and James E. Hawes

This column highlights some of the more notable recent online notices, newsletters, and blogs dealing with IP prosecution issues.

IPWatchdog – a patent law blog – [IPwatchdog.com](http://ipwatchdog.com)

* On May 22, 2019, Eileen McDermott discussed the draft text of proposed new Section 101. The proposed changes are directed towards favoring patent eligibility. The draft text of the bipartisan, bicameral proposal to reform Section 101 of the Patent Act is available at <https://www.tillis.senate.gov/services/files/E8ED2188-DC15-4876-8F51-A03CF4A63E26>. (<https://www.ipwatchdog.com/2019/05/22/draft-text-proposed-new-section-101-reflects-patent-owner-input/id=109498/>).

* On June 12, 2019, Ryan Cagle provided warnings to avoid running afoul of foreign filing license requirements, which can be complicated when companies and universities pursue inventive activities in various nations with inventors of varied citizenship. (<https://www.ipwatchdog.com/2019/06/12/beware-foreign-filing-license-requirements/id=110332/>).

Patently-O – a blog written by Dennis Crouch – www.patentlyo.com.

* In a June 20, 2019 post, Professor Dennis Crouch discussed *Forum US, Inc. v. Flow Valve, LLC*, No. 2018-1765 (Fed. Cir., June 17, 2019) (<http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/18-1765.Opinion.6-17-2019.pdf>) wherein the court applied a heightened written description test for reissue patents. (<https://patentlyo.com/patent/2019/04/%c2%a7-design-patents.html>)

Patent Docs – A patent blog – patent-docs.typepad.com/patent_docs

* On June 16, 2019, Michael Borella reviewed computer-implemented functional claiming under 35 U.S.C. § 112 in light of the USPTO's June 11, 2019 Patent Quality Chat on that topic (https://www.uspto.gov/sites/default/files/documents/6_11_2019%20Patent%20Qual%20Chat.pdf). <https://www.patentdocs.org/2019/06/uspto-presentation-on-evaluating-computer-implemented-functional-claiming-under-35-usc-112.html>.

AIPLA – the profession's national organization – see AIPLA.org

* AIPLA will hold its 2019 Annual Meeting October 24-26, 2019 in Washington, D.C. More information on this meeting and other events is available at <https://www.aipla.org/home/meetings-education/upcoming-events/expand/2019-annual-meeting>.

Miscellaneous –

* The Chisum Patent Academy holds upcoming patent law seminars in Seattle, Washington on August 8-9, 2019. Complete syllabi for all Chisum seminars are available at <http://chisum-patent-academy.com/past-seminars/>. There are a possible 18 CLE credits for these seminars. Each seminar is limited to ten attendees. More info at <https://chisum-patent-academy.com/upcoming-patent-law-seminars/>.

For more information about any of the patent topics mentioned consult *Patent Application Practice*. Trademark topics are discussed in *Trademark Registration Practice*. Both are published by West and updated twice a year. For patent prosecution or litigation questions, contact Fred Douglas at 949/293-0442 or by email at fdouglas@cox.net.



JOIN AN OCIPLA COMMITTEE!

AMICUS COMMITTEE

This committee shall: a) scrutinize judicial decisions which involve significant issues of law or practice which affect intellectual property, (b) recommend to the Board of Directors that amicus curiae briefs be filed in appropriate cases, and (c) draft OCIPLA amicus curiae briefs.

PROFESSIONAL PROGRAMS COMMITTEE

This committee shall identify and recommend curricula to the Board of Directors and assist in coordinating educational programs to be conducted during regular monthly meetings or at other times on topics which: (1) are of interest and benefit to the OCIPLA members; or (2) pertain to the professional activities of OCIPLA members and are of interest to others. The Committee will also assist the Board of Directors in obtaining speakers and otherwise preparing for the presentation of approved educational programs. The Professional Programs Committee shall include a litigation and prosecution subcommittees.

CORPORATE PRACTICE COMMITTEE

This committee shall develop and disseminate information that is particularly useful to in-house attorneys, and promote efficient exchanges of best practices among in-house attorneys. *Co-chairs:*

- **MICHAEL KLINE**, michaelkline@clevelandgolf.com
- **MARK KERTZ**, mark.kertz@medtronic.com

MEMBERSHIP COMMITTEE

This committee shall focus on expanding and diversifying the membership of OCIPLA, and shall work closely with other Committees and the Board of Directors to provide insights as to what IP practitioners in our IP community want from a legal organization and how OCIPLA can better the local IP community.

NEW LAWYERS COMMITTEE

This committee shall focus on members in their first ten years of practice. The Committee shall provide educational and networking opportunities to new lawyers at OCIPLA. In addition, the Committee shall work closely with other Committees to provide new lawyers with opportunities to become more involved in the association, including participating in planning for OCIPLA meetings, coordinating networking events and other social activities for OCIPLA, assisting in research & writing projects, and developing educational materials.

OCIPLA seeks volunteers to serve on Association Committees, whose respective missions are set forth on this page. If you have a few hours a month, we invite you to contact a member of our Board of Directors or the Committee Chairs (identified below) to discuss opportunities to help strengthen the OCIPLA community.

MAKE OCIPLA EVEN BETTER!

LAW STUDENT COMMITTEE

This committee shall serve the law students in the local community, with particular focus on communicating their concerns to the Board of Directors and to welcome more law students to join the association as active members. The Committee shall also work closely with other Committees to provide law students with opportunities to become more involved in the association, including participating in planning for OCIPLA meetings, coordinating networking events and other social activities for OCIPLA, assisting in research & writing projects, and developing educational materials.

NEWSLETTER COMMITTEE

This committee shall identify, recommend to the Board of Directors and prepare high quality, educational material for the OCIPLA Newsletter. *Co-Chairs:*

- **BROCK WILSON**, bfwilson@akingump.com
- **CLARK GORDON**, cgordon@akingump.com

TRADEMARK PRACTICE COMMITTEE

This committee shall consider all aspects of the practice of trademark law before the United States Patent and Trademark Office, aid in the institution of improvements in the administration of the trademark laws by the USPTO; monitor proposed changes in the USPTO Rules of Practice relating to trademark law and, with the advice and consent of the Board of Directors, inform the USPTO as to the position of the Association regarding such proposed changes; receive and coordinate views of members in connection with any existing problems or suggestions for improvements in the USPTO administration, and with the advice and consent of the Board of Directors, forward these views to the USPTO, and make recommendations to the Board of Directors regarding these duties.

COPYRIGHT PRACTICE COMMITTEE

This committee shall consider all aspects of the practice of copyright law before the Copyright Office of the Library of Congress, and to make recommendations to the Board of Directors regarding same.

FORMER PRESIDENT'S COMMITTEE

- **EHAB SAMUEL**, esamuel@mannatt.com
- **MATT LAPPELL**, matt@lappellubell

WOMEN IN IP COMMITTEE

This committee shall promote the role of women in IP law practice in and around Orange County. Membership and participation are open to men as well.

All committees shall consist of members appointed by the Board of Directors for a two-year term.



OCIPLA seeks volunteers to serve on Association Committees, whose respective missions are set forth on this page. If you have a few hours a month, we invite you to contact a member of our Board of Directors or the Committee Chairs (identified below) to discuss opportunities to help strengthen the OCIPLA community.

OCIPLA 2019 Board of Directors

President	Lauren Keller Katzenellenbogen	(949) 721-6365	lauren.katzenellenbogen@knobbe.com
Vice President	Nate Camuti	(949) 275-7852	ncamuti@gmail.com
Secretary	Mark Kertz	(949) 680-1313	mark.kertz@medtronic.com
Treasurer	Marin Cionca	(949) 334-3036	marin@cioncaip.com
Third Year Director	Sarah Bro	(949) 757-6001	sbro@mwe.com
Second Year Director	Nicole Townes	(949) 721-5261	nicole.townes@knobbe.com
First Year Director	Vishwanath Mohan	(949) 829-2186	vkmoan@onellp.com
Immediate Past President	Matt Lapple	(949) 756-4889	matt@lappleubell.com

OCIPLA Newsletter

Copyright © 2019 The Orange County Intellectual Property Law Association. All rights reserved.

Reproduction of this newsletter is authorized if the source, author,
and copyright notice are provided on all reproductions.

Printed in the United States of America.

The OCIPLA Newsletter is a copyrighted publication normally published before each monthly OCIPLA General Meeting. The OCIPLA reserves the right to determine which, if any, submitted articles will appear in this Newsletter.

This document is provided for informational purposes only. The articles contributed by identified authors express only the views of the particular author or authors and do not necessarily reflect the opinions of the Orange County Patent Law Association or its editorial staff. Any questions or comments concerning an article should be directed to its author. Any errors should be brought to the attention of the Editor so that appropriate corrections can be published in a subsequent edition of the Newsletter.

We hope that the Newsletter is informative, entertaining, and interesting. Comments, ideas, announcements, proposed articles, suggestions and any other communications concerning the content, form or other aspect of this Newsletter may be directed to:

Sarah Bro
2019 OCIPLA Newsletter Editor

